

prize, the gaming machine being characterized in that wherein the improvement comprises the display means ~~displays~~ displaying a plurality of spinning reels, each reel carrying symbols from a set of symbols, one of the symbols of the set being a scatter symbol and, in respect of at least one of the reels, the set comprising ~~more than one occurrence~~ a plurality of the scatter symbols, at least certain of the scatter symbols on said at least one reel being ~~arranged~~ separated from each other on the reel by at most one other symbol so that ~~more than one scatter symbol is able to be displayed simultaneously when the reels are in a rest condition and, when more than a minimum number of scatter symbols are displayed simultaneously at any one time when the reels are in a rest condition,~~ all the displayed scatter symbols ~~contributing~~ contribute to a single paying combination of the scatter symbols.

Claims 1 and 3-5 are rejected under 35 U.S.C. §102(b) as being anticipated by Slot Machines A Pictorial Review - 1973 Bally "Circus" (referred to below as "Bally"), while claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over Bally. The Examiner alleges that Bally discloses a mechanical reel slot machine having a circus theme and that it additionally discloses, with respect to claim 1:

- the display means displays a plurality of spinning reels,
- each reel carrying symbols from a set of symbols,
- one of the symbols (monkey symbol) of the set of symbols on the reels of a gaming machine is a scatter symbol,
- in respect to at least one of the reels, the set comprising a plurality of the scatter symbols (monkey symbols), at least certain of the scatter symbols on said at least one reel being separated from each other on the reel by at most one symbol, so that when more than a minimum number of scatter symbols are displayed simultaneously at any one time when the reels are in a rest condition, all the displayed scatter symbols contribute to a single paying combination of the scatter symbols.

It is further stated that Bally discloses "an unusual play feature..... the monkey special, which pays 20 coins for three monkeys in any position in the reel glass" (emphasis added). Based on this quoted passage, the Examiner is of the view that the monkey special could be three

monkeys displayed on the same reel, two monkeys on one reel (adjacent or separated by one symbol) and another monkey displayed on any one of the two remaining reels, etc.

With respect, the Examiner appears to have misunderstood the phrase "in any position" as used in the description of the Bally machine. In gaming machines, winning combinations of symbols must appear on a payline or, in gaming machines having multiple paylines, on any one or more of the paylines. In the case of Bally, if one has reference to the illustration on page 118, it is quite clear that Bally only has a single, central payline. What is meant by the phrase "in any position" in the passage relied on by the Examiner means that, because the monkey symbols are scatter symbols, they need not be on the payline when spun up into a visible position on the gaming machine.

As illustrated in Bally, each reel has three reel positions visible in the display. For any other symbols on the reels, only the symbols in the second or centermost position of each reel, i.e. the symbols appearing on the payline, contribute to a winning outcome. As the term "scatter symbol" suggests, the scatter symbol need not occur on the payline. Thus, for example, in respect of the first reel the monkey symbol could appear in the first, top, visible position or the third, bottom, visible position and similarly with respect to reels 2 and 3. Even though the monkey symbol does not appear on the payline, the mere fact that it is in a visible position on the display contributes to a winning outcome. This is therefore the context in which the passage "in any position" has been used in the quoted passage.

It must be emphasized that one of ordinary skill in the art would not regard "in any position" as used in the description of the Bally machine to refer to more than one occurrence of the scatter symbol alongside or spaced from another scatter symbol by at most one other symbol as has been interpreted by the Examiner. As indicated, the term "in any position" has the standard meaning that the scatter symbols need not appear on the payline in order to contribute to a winning outcome. Absent a specific teaching or motivation in the Bally reference, extending such "in any position" standard meaning beyond the Bally reference to that represented by the claimed invention would clearly constitute the application of improper hindsight.

Regarding the rejections of claims 2-5, these rejections have been traversed above with reference to claim 1 and are believed to be allowable through dependency.

The Applicant therefore respectfully requests reconsideration and withdrawal of the 35 U.S.C. §102(b) rejections since it is well established that, in respect of a novelty objection, the prior art must disclose all the integers of the invention as claimed. ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).

In addition, in the absence of any teaching or suggestion in Bally of the claim element: *in respect of at least one of the reels, the set comprising a plurality of the scatter symbols, at least certain of the scatter symbols on said at least one reel being separated from each other on the reel by at most one other symbol so that, when more than a minimum number of scatter symbols are displayed simultaneously at any one time when the reels are in a rest condition, all the displayed scatter symbols contribute to a single paying combination of the scatter symbols*, anticipation of the present invention is necessarily negated. This is because all the elements of the claimed invention are not disclosed in a single reference, and in particular Bally. *Atlas Powder Co. v E. I. DuPont de Nemours & Co.*, 750 F.2d 1569, 224 U.S.P.Q. 409 (Fed. Cir. 1984). Therefore, there is no anticipation of the present invention, as now claimed, and Applicant again respectfully requests reconsideration and the withdrawal of the 35 U.S.C. §102(b) rejections to the allowable independent claim 1 and all the similarly-rejected claims depending therefrom, as well as the §103(a) rejection to claim 2 through dependency.

Moreover, it is respectfully submitted that the invention as presently claimed is patentable over Bally since what is claimed in the present invention is, in fact, a new style of scatter pay as discussed in the Applicant's earlier response of September 26, 2003. The idea of having a potential winning payout of 15 scatter symbols, which is possible with the present invention, is totally different from the standard concept of a scatter symbol as taught by Bally. The availability of numerous scatter symbols occurring in visible positions on each of the reels facilitates completely different payouts and winning combinations which is not taught or suggested by Bally. It is respectfully submitted, therefore, that one of ordinary skill in the art

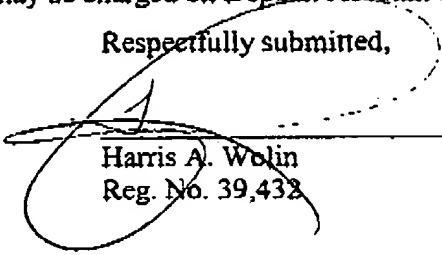
would not be taught or motivated to arrive at the claimed invention with reference to Bally, since Bally clearly fails to reach the totality of the claimed invention (*Gillette Co v S C Johnson and Son Inc.*, 16 U.S.P.Q.2d 1923, 1927 (Fed. Cir.)). Accordingly, it is respectfully submitted that the claimed invention is patentable over the cited art, and in particular the Bally reference.

For the reasons set out above, reconsideration is therefore respectfully requested.

In view of the above remarks, it is believed that claims 1-5, consisting of independent claim 1 and the claims depending therefrom, are in condition for allowance. Passage of this case to allowance is earnestly and respectfully solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,



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